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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,130	12/19/2005	James C. Muth	353.324	8714
23598 7590 12/10/2008 BOYLE FREDRICKSON S.C. 840 North Plankinton Avenue MILWAUKEE, WI 53203				
EXAMINER				
ING, MATTHEW W				
ART UNIT		PAPER NUMBER		
3637				
NOTIFICATION DATE		DELIVERY MODE		
12/10/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@boylefred.com

### Office Action Summary

**Application No.**

10/542,130

**Applicant(s)**

MUTH ET AL.

**Examiner**

MATTHEW W. ING

**Art Unit**

3637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 9-11, 14-16 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-11, 14-16, & 20-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**542130DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claims 1 & 7 fail(s) to recite sufficient structural elements and interconnection of the elements to positively position and define the structure(s) & component(s) whereby the wheel arrangement or wheel brackets are rendered capable of being "engaged with the assembled storage unit after assembly of the storage unit", so that an integral structure able to function as claimed is recited.
4. Claims 2-6 are rendered indefinite by their dependence upon an indefinite base claim.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1-7 & 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahl (3,286,651). Dahl teach(es) the structure substantially as claimed, including a storage unit (10). The only difference between Dahl and the invention as claimed is that Dahl fail(s) to clearly teach a storage unit formed as a kit of disassembled, assemblable components; as well as a plurality of storage units. However, whereas constructing a formerly integral structure in various elements and putting them together has been held to involve only routine skill in the art, it

therefore would have been obvious to one of ordinary skill in the art to make separable & assemblable the various components of Dahl, in order to allow easier transportation thereof; and whereas mere duplication of the essential working parts of a device has been held to involve only routine skill in the art, it therefore would have been obvious to one of ordinary skill in the art to include a plurality of storage units, as taught by Dahl, in order to increase available storage capacity, thereby providing the structure substantially as claimed.

7. Regarding claim 1, Dahl teaches a storage system, comprising: a storage unit (11-12 & 14); a wheel arrangement (Items 16, as well as 18, 20, 22 at the front corner of 10); and a guide arrangement including at least one rail (28); wherein the storage unit, the wheel arrangement and the guide arrangement comprise a set of components that are capable of being transported together in a disassembled state to an installation site including a support surface, and to be assembled at the installation site, wherein the wheel arrangement is engaged (via 22) with the storage unit and wherein the at least one rail of the guide arrangement is adapted to be secured (via 33) to the support surface of the installation site, and wherein the storage unit when assembled is engageable (via 18) with the at least one rail via the wheel arrangement to provide movement of the storage unit on the at least one rail relative to the support surface. It is noted that whereas the wheel arrangement of Dahl is obviously capable of being engaged (via 22) with the storage unit (11-12 & 14) thereof after assembly of the latter, the structure of Dahl, as modified, is therefore viewed as reading upon the limitations of claims 1 & 7. It is additionally noted that even if, *arguendo*, the use of rivets (e.g., 22) is viewed as hindering disassembly of the structure of Dahl, the examiner takes official notice that the use of nuts & bolts in lieu of rivets is well-known in the art; and that as such, it therefore would have been obvious to one of ordinary

skill in the art to substitute nuts & bolts for the rivets of Dahl, in order to allow easier replacement of the components thereof; and since the results of such a substitution would have been predictable; thereby providing the structure substantially as claimed.

8. Regarding claim 2, Dahl teaches a storage system comprising a stop arrangement (34) capable of being transported together with the storage unit (11-12 & 14), the wheel arrangement (18, 20, 22) and the guide arrangement (28), wherein the stop arrangement is interposed between the storage unit and the rail to control the range of movement of the storage unit relative to the rail. See Fig. 1.

9. Regarding claim 3, Dahl teaches a storage system further comprising a retainer arrangement (18 at the rear of 10) contained within the kit, wherein the retainer arrangement (18) is separate from the wheel arrangement (18, 20, 22 at the front corner of 10) and is configured to be carried by the storage unit (11-12 & 14) and to selectively engage the rail to selectively prevent movement (i.e., perpendicular to the guide arrangement) of the storage unit on the guide arrangement and to thereby fix the position of the storage unit relative to the support surface.

10. Regarding claim 4, Dahl teaches a storage system, wherein the rail is adapted to be adhesively secured (via 33) to the support surface of the installation site. See col. 3, lines 5-14.

11. Regarding claim 5, Dahl teaches a storage system wherein the rail is adapted to be adhesively secured to the support surface by means of an adhesive (33) interposed between the support surface and a facing engagement surface defined by the rail.

12. Regarding claim 6, Dahl teaches a storage system, wherein the adhesive comprises an adhesive member (33) secured to the engagement surface of the rail.

13. Regarding claim 7, Dahl teaches a storage system, wherein the storage unit (11-12 & 14) defines a series of lower corners when the storage unit components are assembled together to form a storage unit, and wherein the wheel arrangement (Items 16, as well as 18, 20, 22 at the front corner of 10) comprises a plurality of wheel brackets (20) each including a wheel (16 or 18) and configured to be secured with one of the corners of the storage unit after the storage unit is assembled, in either a first orientation providing movement of the storage unit in a first direction or a second orientation providing movement of the storage unit in a second direction transverse to the first direction, and wherein the rail is adapted to be engaged with the support surface so as to guide movement of the storage unit in either the first direction or the second direction. The examiner submits that whereas the wheel arrangement (18, 20, 22) on each corner is clearly capable of being secured to the storage unit in a direction transverse to the direction shown, the structure of Dahl therefore reads upon the limitations of this claim.

14. Regarding claim 9, Dahl teaches a storage system: a plurality of storage units (11-12 & 14), wherein the storage unit (11-12 & 14) defines a series of lower corners; a guide arrangement (28) configured for engagement with a support surface, wherein the guide arrangement includes at least one guide rail for each storage unit; and a series of wheeled brackets (16, 18, 20, 22) separate from and engagable with the lower corners of the storage units, wherein each wheel bracket includes a wheel (16 or 18) and defines corner engagement structure (22), wherein the corner engagement structure is configured to engage & receive one of the lower corners of the storage unit; wherein each wheel bracket is configured such that the wheel of the wheel bracket is interposed between one of the corners of the storage units and the guide arrangement, wherein the wheel brackets are separate from the storage units and include corner engagement structure

(22) configured to engage the corners of the storage unit in either a first or second orientation so as to position the wheels in either a first direction or a second direction, respectively, relative to the storage unit, and wherein the guide rails (28) are adapted to be engaged with the support surface such that movement of the storage units on the guide rails provides movement of the storage units in a first direction when the wheeled members are in the first orientation or in a second direction transverse to the first direction when the wheeled members are in the second orientation.

15. Regarding claim 10, Dahl teaches a storage system, wherein the storage unit (11-12 & 14), the wheeled members (18, 20, 22) and the guide arrangement (28) comprise a set of components that are clearly capable of being transported together in a disassembled state to an installation site including the support surface, and of being assembled at the installation site wherein the at least one rail (28) of the guide arrangement is adapted to be secured to the support surface of the installation site, and wherein the storage unit (10) when assembled is engageable with the at least one rail via the wheeled members (18, 20, 22) to provide movement of the storage unit on the at least one rail relative to the support surface.

16. Regarding claim 11, Dahl teaches a storage system, wherein the rail is adapted to be adhesively secured (via 33) to the support surface of the installation site.

17. Claims 9-11 can be alternately rejected, along with claim 14, under 35 U.S.C. 103(a) as being unpatentable over Baker (3,967,868).

18. Baker teach(es) the structure substantially as claimed, one or more storage units (14); a guide arrangement (18) including at least one rail member secured to a support surface; and a series of wheel members (36) mounted to each storage unit, wherein at least a pair of the wheel

members are configured to engage the rail member (18) to provide guided movement of the storage unit relative to the support surface; wherein said rails & wheel members are capable of being oriented, and configured to move, along either of two tranverse, perpendicular directions (col. 7, lines 11-22). The only difference between Baker and the invention as claimed is that Baker fail(s) to clearly teach the method as claimed by applicant; or storage units in a disassembled state.

19. However, whereas Baker teach(es) all aspects of the structure associated with the method claimed therein, it therefore would have been obvious to one of ordinary skill in the art, in view of the structure of Baker, to construct said structure via the method claimed by applicant, thereby providing the method substantially as claimed.

20. Additionally, whereas constructing a formerly integral structure in various elements and putting them together has been held to involve only routine skill in the art, it therefore would have been obvious to one of ordinary skill in the art to make separable & assemblable the various components of Baker, in order to allow easier transportation thereof, thereby providing the structure substantially as claimed.

21. Regarding claims 9 & 14, Baker teaches a storage system: a plurality of storage units (14), wherein the storage unit (14) defines a series of lower corners; a guide arrangement (18) configured for engagement with a support surface, wherein the guide arrangement includes at least one guide rail for each storage unit; and a series of wheeled brackets (36) separate from and engagable with the lower corners of the storage units, wherein each wheel bracket includes a wheel (68) and defines corner engagement structure (106), wherein the corner engagement structure is configured to engage & receive one of the lower corners of the storage unit (Fig. 2);



wherein each wheel bracket is configured such that the wheel (68) of the wheel bracket is interposed between one of the corners of the storage units and the guide arrangement, wherein the wheel brackets (36) are separate from the storage units (14) and include corner engagement structure (106) configured to engage the corners of the storage unit in either a first or second orientation so as to position the wheels in either a first direction or a second direction, respectively, relative to the storage unit (col. 7, lines 11-22), and wherein the guide rails (18) are adapted to be engaged with the support surface such that movement of the storage units on the guide rails provides movement of the storage units in a first direction when the wheeled members are in the first orientation or in a second direction transverse to the first direction when the wheeled members are in the second orientation.

22. Regarding claim 10, Baker teaches a storage system, wherein the storage unit (14), the wheeled members (36) and the guide arrangement (18) comprise a set of components that are clearly capable of being transported together in a disassembled state to an installation site including the support surface, and of being assembled at the installation site wherein the at least one rail (18) of the guide arrangement is adapted to be secured to the support surface of the installation site, and wherein the storage unit (14) when assembled is engageable with the at least one rail via the wheeled members (36) to provide movement of the storage unit on the at least one rail relative to the support surface.

23. Regarding claim 11, Dahl teaches a storage system, wherein the rail (18) is obviously capable of being adhesively secured to the support surface of the installation site.

24. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baker (3,967,868) as applied to the claim(s) above, further in view of Hoska (5,597,217). Baker

teach(es) the structure substantially as claimed, including storage units (14) and rail members (18). The only difference between Baker and the invention as claimed is that Baker fail(s) to clearly teach rail members positioned in an end-to-end configuration. Hoska, however, teaches rail members (12) positioned in an end-to-end configuration. It would have been obvious to one of ordinary skill in the art to modify the structure of Baker by positioning additional rails end-to-end therein in order to extend the length of travel of the storage units, thereby providing the structure substantially as claimed.

25. Regarding claim 15, whereas Baker as modified by Hoska teach(es) all aspects of the structure associated with the method claimed therein, it therefore would have been obvious to one of ordinary skill in the art, in view of the structure of Baker as modified by Hoska, to construct said structure via the method claimed by applicant, thereby providing the method substantially as claimed.

26. Claims 16 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker (3,967,868) and Hoska (5,597,217) as applied to the claim(s) above, further in view of Dahl (3,286,651). Baker & Hoska teach(es) the structure substantially as claimed, including a rail members (18 in Baker). The only difference between Baker & Hoska and the invention as claimed is that Baker & Hoska fail(s) to teach rail members adhesively secured to a support surface and a stop arrangement positioned between rail members and storage units; wherein said stop arrangement is secured to each of a pair of spaced ends, or between a pair of adjacent rail members. Dahl, however, teaches adhesively securing a rail (28) to a support surface (via 33), as well as a stop (34) positioned between said rail member and a storage unit (10). It would have been obvious to one of ordinary skill in the art to adhesively mount the rail of Baker as modified

by Hoska to a support surface, and to include one or more stops upon said rail, as taught by Dahl, in order to firmly mount said rail to a support surface, and to prevent undesired movement by said storage unit(s), thereby providing the structure substantially as claimed.

27. Regarding claims 21-23, the examiner points out that mere rearrangement of the essential working parts of a device has been held to involve only routine skill in the art, and that a stop positioned at the joint between two rail members (thus overlapping each), or at each end of a rail member, would meet the limitations of the claim.

28. Regarding claim 23, the examiner points out that the front portion of a rail member (18) of Baker as modified by Hoska & Dahl can be termed a "wheel guide", since it acts to channel the movement of a wheel. The examiner also points out that the wheel members, rail members, & stop member of the storage unit are all capable of being positioned according to the position mentioned in the claim.

29. Regarding claims 16 and 20-23, whereas Baker, Hoska, & Dahl teach(es) all aspects of the structure associated with the method claimed therein, it therefore would have been obvious to one of ordinary skill in the art, in view of the structure of Baker, Hoska, & Dahl, to construct said structure via the method claimed by applicant, thereby providing the method substantially as claimed.

30. Claims 20-23 can be alternately rejected under 35 U.S.C. 103(a) as being unpatentable over Baker (3,967,868) and Hoska (5,597,217) as applied to the claim(s) above, further in view of Brown (4,807,765). Baker & Hoska teach(es) the structure substantially as claimed, including a rail arrangement. The only difference between Baker & Hoska and the invention as claimed is that Baker & Hoska fail(s) to teach a stop arrangement positioned at spaced-apart ends of said

rail, or to secured to an end area defined by each of a pair of adjacent rail members. Brown, however, teaches a stop arrangement (combination of 51-53 & 36) positioned at spaced-apart ends of a rail, or to secured to an end area defined by each of a pair of adjacent rail members. It would have been obvious to one of ordinary skill in the art to include a stop arrangement, as taught by Brown, upon the rails of Baker as modified by Hoska, in order to reduce the ability of the storage units to move in undesired directions, thereby providing the structure substantially as claimed.

31. Regarding claims 20-23, whereas Baker, Hoska, & Brown teach(es) all aspects of the structure associated with the method claimed therein, it therefore would have been obvious to one of ordinary skill in the art, in view of the structure of Baker, Hoska, & Brown, to construct said structure via the method claimed by applicant, thereby providing the method substantially as claimed.

#### ***Response to Arguments***

32. Applicant's arguments filed 9/15/08 have been fully considered but they are not persuasive.

33. Applicant's arguments with respect to claims 1-7, 9-11, 14-16, & 20-23 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

34. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW W. ING whose telephone number is (571)272-6536. The examiner can normally be reached on Monday through Friday, 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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MWI  
26 November 2008

/José V. Chen/  
Primary Examiner, Art Unit 3637